



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,467	04/16/2001	Randy James	57443-010003	8059

7590

01/16/2004

Joseph H. Paquin, Jr.
McDermott, Will & Emery
227 West Monroe
Chicago, IL 60606

EXAMINER

FERGUSON, KEITH

ART UNIT PAPER NUMBER

2683

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/835,467

Applicant(s)

JAMES ET AL.

Examiner

Keith T. Ferguson

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13,14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2683

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michaud.

Regarding claim 13, Michaud discloses a wireless digital communication method (fig. 5 and col. 2 line 57 through col. 3 line 15) comprising; encoding message information (i.e. with data base information, and programming information) (col. 3 line 65 through col. 4 line 13) in the vertical blanking interval of an outgoing video signal transmitted from a first location (headend) (col. 3 lines 4-35, col. 3 line 65 through col. 4 line 13), said out-going video signal having a carrier (broadcast channel) (col. 3 line 65 through col. 4 line 13); receiving at a settop terminal 20 said out-going video signal (col. 3 line 65 through col. 4 line 13). Michaud differs from claim 13 of the present invention in that it does not explicit disclose transmitting a return signal on said carrier of said out-going signal. However, Michaud disclose the settop termial has a transmitter which permits transmission of communication upstream to the headend if interactive communication are desired (col. 3 lines 35-45). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made for transmitting a return signal on said carrier of said out-going signal in order to inform the headend that the consumer would like to purchase a pay-per-view event.

Art Unit: 2683

Regarding claim 14, Michaud discloses a transceiver (receiver/transmitter) (fig. 3 numbers 115 and 103) for use in a wireless digital communication system (fig. 1) comprising: a receiver for receiving message information encoded in the vertical blanking interval of a video signal having a carrier (col. 3 line 65 through col. 4 line 13). Michaud differs from claim 14 of the present invention in that it does not explicit disclose a transmitter for transmitting message information on said carrier of said video signal. However, Michaud disclose a settop terminal that has a transmitter which permits transmission of communication upstream to the headend if interactive communication are desired (col. 3 lines 35-45). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a transmitter for transmitting message information on said carrier of said video signal in order to inform a headend that the consumer would like to purchase a pay-per-view event.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith T. Ferguson whose telephone number is (703) 305-4888. The examiner can normally be reached on 6:30am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703) 308-5318. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

Application/Control Number: 09/835,467

Page 4

Art Unit: 2683

Keith Ferguson *KK*

Art Unit 2683

January 2, 2004